

REMARKS

Applicants have carefully considered the points raised in the Office Action and believe that the Examiner's concerns have been addressed as described herein, thereby placing this case into condition for allowance.

Status of the claims

Claims 1, 3-16, 18-31, 33-34, 36-41, 43, 44, 46-57 and 59-65 are pending. Claims 1, 3, 16, 18-31, 33-34, 36-41, 43-44, and 46-56 were previously withdrawn from consideration as drawn to a nonelected invention, and the species of cationic lipid was elected for searching purposes, resulting in withdrawal of claim 62 as drawn to a nonelected species. Claims 57, 59-61, and 63-65 are currently under consideration.

Applicants reiterate the request for consideration of claims to additional species upon allowance of a generic claim, as set forth in 37 C.F.R. §1.141(a). Applicants also reiterate the request for rejoinder of withdrawn method claims upon allowance of the elected composition claims from which they depend, in accordance with MPEP §821.04.

Priority

The Office Action states that the priority to PCT/SG00/00130 is denied because the specification does not state the relationship between PCT/SG00/00130 and the instant application.

A petition under 37 C.F.R. §1.78(a) to accept an untimely benefit claim was filed on November 4, 2005, along with a proposed amendment to the specification to recite the relationship between PCT/SG00/00130 and the instant application. The petition was denied solely on the basis of a clerical error in the PCT application number for PCT/SG00/00130 in the proposed amendment. A renewed petition under 37 C.F.R. §1.78(a)(3) is submitted concurrently herewith, with a revised amendment to the specification in which this clerical error has been corrected.

The decision on the petition filed on November 4, 2005 stated that the Examiner indicated that the proposed amendment to the specification would not be entered because the amendment would render claims 57, 59-61, and 63-65 allowable, and would necessitate rejoinder of withdrawn method claims, allegedly requiring further search and consideration. The decision further stated that since the amendment does not *prima facie* place the application in condition for allowance, Applicants must submit a Notice of Appeal, a Request for Continued Examination, or file a continuation application. A Request for Continued Examination is filed concurrently herewith. Applicants respectfully request entry of the proposed amendment to the specification in the concurrently-filed Renewed Petition under 37 C.F.R. §1.78(a)(3).

Certified Copy of Australian Provisional Application No. PQ2593/99

The Office Action states that the priority claim to Australian Provisional Application No. PQ2593/99, filed September 1, 1999, is denied because no certified copy of this document has been received by the U.S. Patent and Trademark Office. A certified copy of this application is filed herewith.

The Office Action further states that the priority claim to PCT/SG00/00130, filed September 1, 2000, is denied because no certified copy of this document has been received by the U.S. Patent and Trademark Office. A certified copy of this application has been requested and will be forwarded to the Office upon receipt.

Specification

The Examiner states that the Preliminary Amendment filed on March 1, 2002 is objected to because it allegedly introduces new matter into the disclosure. The Examiner states that the amendment to the specification, which added a priority claim to PCT/SG00/00130, is new matter because the Declaration for Utility Patent Application did not indicate that the specification as filed was amended. Applicants respectfully disagree that amending the cross-reference section of the specification to add a reference to a parent application is new matter. The specification *as filed* was not amended, as asserted by the Examiner. The specification as filed was a copy of the specification

of the PCT application from which this application claims priority. A Preliminary Amendment was filed concurrently, for which entry was *requested*. Filing a Preliminary Amendment to update cross-reference information in an application does not add new matter. The Preliminary Amendment was filed as a separate document from the specification and was clearly indicated on the Utility Patent Application Transmittal under the section entitled “*Accompanying Application Parts*” (emphasis added).

The Examiner further states that the amendment to incorporate PCT/SG00/00130 by reference is new matter. In the accompanying proposed amendment to the specification in the concurrently-filed Renewed Petition Under 37 C.F.R. §1.78(a)(3), the incorporation by reference statement has been revised to recite the original language in the specification as filed.

In view of the foregoing, Applicants respectfully request withdrawal of the objection to the Preliminary Amendment filed on March 1, 2002.

Rejection under 35 U.S.C. §102(b)

Claims 57 and 59-61 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Lawrencia et al., *Conference Supplement to Cancer Gene Therapy, Gene Therapy of Cancer VII*, 12/1999, as evidenced by Lawrencia et al. (2001) *Gene Therapy* 8:760-768, for reasons of record in the previous Office Action. Applicants respectfully traverse this rejection.

As discussed in the response filed on July 15, 2005, both of the cited references were published after the priority date for this application. This application claims priority to Australian provisional application no. PQ2593/99, which was filed on September 1, 1999. The cited references both published after this date, and are therefore not available as prior art.

The Office Action states that Applicants’ arguments are unpersuasive because the priority claims for this application are denied. As discussed above, a Renewed Petition under 37 C.F.R. §1.78(a)(3) is filed concurrently herewith. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §102(b) upon granting of this petition.

Rejection under 35 U.S.C. §103(a)

Claims 57 and 63 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Lawrencía et al., *Conference Supplement to Cancer Gene Therapy, Gene Therapy of Cancer VII*, 12/1999, in view of Woodle et al (U.S. Patent Application No. 2003/0166601, published 9/4/03), for reasons of record in the previous Office Action. Applicants respectfully traverse this rejection.

As discussed in the response filed on July 15, 1005, Lawrencía et al. is not available as prior art since it published after the priority date of the present application, and therefore cannot serve as an underlying reference to support an obviousness rejection.

The Office Action states that Applicants' arguments are unpersuasive because the priority claims for this application are denied. As discussed above, a Renewed Petition under 37 C.F.R. §1.78(a)(3) is filed concurrently herewith. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a) upon granting of this petition.

Claims 57, 64, and 65 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Felgner et al. (U.S. Patent No. 5,580,859, issued 3/18/94) in view of Lawrencía et al., *Conference Supplement to Cancer Gene Therapy, Gene Therapy of Cancer VII*, 12/1999), for reasons of record in the previous Office Action. Applicants respectfully traverse this rejection.

As discussed in the response filed on July 15, 2005, Lawrencía et al. is not available as prior art since it published after the priority date of the present application, and therefore cannot serve as an underlying reference to support an obviousness rejection.

The Office Action states that Applicants' arguments are unpersuasive because the priority claims for this application are denied. As discussed above, a Renewed Petition under 37 C.F.R. §1.78(a)(3) is filed concurrently herewith. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §103(a) upon granting of this petition.

CONCLUSION

If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 578762000100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: March 7, 2006

Respectfully submitted,

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